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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/643,554	08/22/2000	Richard Alan Fiedotin	61018-0008-US	9688
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MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			GILLIGAN, CHRISTOPHER L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/643,554	FIEDOTIN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Luke Gilligan	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 April 2005.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 3-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

***Response to Amendment***

1. In the amendment filed 4/14/05, no claims have been amended. Now, claims 1 and 3-30 are presented for examination.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-11, 15-16, 18-21, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, U.S. Patent No. 5,845,255 in view of Kaker et al., U.S. Application Publication No. 2001/0037218.

4. As per claim 1, Mayaud teaches a method for renewing a prescription for a pharmaceutical via an electronic network, comprising the steps of: computer generating a prescription renewal request for the renewal of a prior prescription (see column 19, lines 48-53 and lines 63-67); receiving a renewal prescription, in response to said prescription renewal request from a prescriber (see column 20, lines 50-60); and notifying a dispenser to fill said renewal prescription (see column 20, lines 5-11 and column 32, lines 23-25). Mayaud does not explicitly teach computer monitoring an expiration date of a prescription, generating the renewal request based on the computer monitoring, and transmitting the prescription renewal request to a prescriber. Kaker teaches a system that computer monitors an expiration date of a prescription (see paragraph 146); generates a renewal request prior to said expiration date based on said computer monitoring and without patient involvement (see paragraph 147); and transmitting the prescription renewal request to a prescriber (see paragraph 155). It would have

been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate these features for the purpose of aiding physicians in tracking and monitoring prescription drugs needed by indigent patients (see paragraph 6).

5. As per claim 3, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches the generating step further comprises creating said prescription renewal request from the following: a patient identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a prescriber identifier, a dosage, number of refills, and a strength (see Figure 3).

6. As per claim 4, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches prior to said receiving step, providing information useful to said prescriber for reviewing said prescription renewal request (see column 20, lines 32-40).

7. As per claim 5, Mayaud in view of Kaker teach the method of claim 4 as described above. Mayaud further teaches said information is selected from the following: warnings for any drug-drug reactions, formulary listings, patient medication history, and low cost therapeutic alternatives (see column 20, lines 20-40 and column 21, liens 34-51).

8. As per claim 6, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches said receiving step further comprises the step of acquiring a renewal prescription, wherein said renewal prescription has components that have been changed from said prior prescription (see column 20, lines 50-56, note that the renewal takes place "after editing").

9. As per claim 7, Mayaud in view of Kaker teach the method of claim 6 as described above. Mayaud further teaches said components are selected from the following: a patient

identifier, a pharmaceutical identifier, a dispenser identifier, a prescription identifier, a prescriber identifier, a dosage, number of refills, and a strength (column 20, lines 50-56 and Figure 3).

10. As per claim 8, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches said receiving step further comprises the step of acquiring an appeal from said prescriber for a patient of said prior prescription to contact said prescriber (see column 23, lines 29-39).
11. As per claim 9, Mayaud in view of Kaker teach the method of claim 8 as described above. Mayaud further teaches said acquiring step further comprises notifying said dispenser to inform said patient to contact said prescriber (column 23, lines 29-39).
12. As per claim 10, Mayaud in view of Kaker teach the method of claim 8 as described above. Mayaud further teaches said acquiring step further comprises notifying said patient to contact said prescriber (see column 23, lines 29-39).
13. As per claim 11, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches the steps of claim 1 occur for a plurality of prescription renewal requests and renewal prescriptions (see column 20, lines 50-60).
14. As per claim 15, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches deleting said electronic prescription renewal request after a set time (see column 15, lines 41-47).
15. As per claim 16, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches deleting said renewal prescription after a set of time (see column 15, lines 41-47).
16. As per claim 18, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches receiving said prior prescription (see column 20, lines 50-51); determining whether a prescribed pharmaceutical from said prior prescription is on formulary

(see column 32, lines 7-13); and dispensing said prescribed pharmaceutical based on said determining step (see column 32, lines 23-25).

17. As per claim 19, Mayaud in view of Kaker teach the method of claim 18 as described above. Mayaud further teaches ascertaining whether said prescribed pharmaceutical is a chronic medication (see column 20, lines 41-49 and Figure 3, the patient history would indicate if a prescription had been prescribed for a chronic illness); and storing a result of said ascertaining step (see column 20, lines 41-49 and Figure 3, this result is at least temporarily stored in the memory of the portable computing device).

18. As per claim 20, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches the initial step of determining whether refills are available for said prior prescription (see Figure 3, reference 100).

19. As per claim 21, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches obtaining a patient record, said record containing at least a patient identifier, a pharmaceutical identifier for a currently prescribed pharmaceutical, a number of authorized refills of the currently prescribed pharmaceutical, and a date of the last filling of the currently prescribed pharmaceutical (see Figure 3); and setting a renewal date before a last refill has been consumed by a patient if said number of authorized refills is greater or equal to a predetermined number (see column 26, lines 57-60).

20. As per claim 26, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches setting a renewal date prior to expiration of said prescription (see column 20, lines 50-56). Mayaud does not explicitly teach determining when a prescription will expire and determining whether said renewal date has been reached. Kaker teaches a method for determining when a prescription will expire and determining whether a renewal date has been reached (see paragraph 155). It would have been obvious to one of

ordinary skill in the art of prescription management to incorporate this feature into the system of Mayaud along with the teachings of nevoca for the reasons given above with respect to claim 1.

21. As per claim 27, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches said prescription comprises multiple prescriptions for a patient (see column 20, lines 5-13).
22. As per claim 28, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches said prescription comprises multiple prescriptions for multiple patients (see column 4, lines 48-55).
23. As per claim 29, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches said prescription comprises a prescription for multiple patients (see column 4, lines 48-55).
24. As per claim 30, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud does not explicitly teach the computer monitoring occurs without patient intervention. Kaker teaches said computer monitoring occurring without patient intervention (see paragraph 155). It would have been obvious to one of ordinary skill in the art of prescription management to incorporate this feature into the system of Mayaud for the reasons given above with respect to claim 1.
25. Claims 12-14, 17, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, U.S. Patent No. 5,845,255 in view of Kaker et al., U.S. Application Publication No. 2001/0037218 and further in view of **nevoca.com Enhances Prescription Verification System** (hereinafter nevoca).
26. As per claim 12, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud does not explicitly teach ascertaining a status of said prescription renewal

request. Nevoca teaches ascertaining a status of said prescription renewal request (see paragraph 9). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of decreasing time spent processing prescriptions (see paragraph 2 of nevoca).

27. As per claim 13, Mayaud in view of nevoca and Kaker teach the method of claim 12 as described above. Mayaud does not explicitly teach determining how many prescription renewal requests were transmitted to said prescriber and establishing how many prescription renewal requests said prescriber has addressed. Nevoca teaches these determining and establishing steps (see paragraph 9, the Examiner asserts that these steps would be necessary to determine the "exact status" when a doctor has not yet responded to a prescription renewal request). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud for the reasons given above with respect to claim 12.

28. As per claim 14, Mayaud in view of nevoca and Kaker teach the method of claim 12 as described above. Mayaud does not explicitly teach sending the status to said prescriber. Nevoca teaches said ascertaining step further comprises the step of sending said status to said prescriber (see paragraphs 4 and 9). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to incorporate this feature into the system of Mayaud for the reasons given above with respect to claim 12.

29. As per claim 17, Mayaud in view of Kaker teach the method of claim 1 as described above. Mayaud further teaches accepting said prescription renewal request using a portable computing device (see column see column 7, lines 57-67); displaying said prescription renewal request, via said portable computing device, to said prescriber (see column 7, lines 57-67);

showing said prescriber information, via said portable computing device, useful for reviewing said prescription renewal request (see column 7, lines 57-67 and Figure 3); and communicating said renewal request to using said portable computing device (see column 7, lines 57-67 and Figure 3, in particular, reference 80). Mayaud does not explicitly teach electronic transmission of a request via a server as described above with respect to claim 1. Nevoca teaches a system for electronically communicating prescription renewal requests to doctors as a result of call-in or walk-in requests (see paragraphs 4 and 7, note that communication is done on-line through nevoca.com and, as such, requires a host server). It would have been obvious to one of ordinary skill in the art of prescription management at the time of the invention to include this feature in the system of Mayaud. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of decreasing time spent processing prescriptions (see paragraph 2 of nevoca).

30. Claims 22 and 23 contain substantially similar limitations to claims 1, 5 and 17 and, as such, are rejected for similar reasons as given above.

31. Claims 24 and 25 contain substantially similar limitations to claims 1 and 17 and, as such, are rejected for similar reasons as given above.

### ***Response to Arguments***

32. In the remarks filed 4/14/05, Applicants argue in substance that (1) Mayaud does not teach generating a prescription renewal request; (2) Mayaud does not teach receiving a prescription renewal request; (3) the “calculation” in Kaker is not a form of computer monitoring as recited in the claim; (4) Kaker does not teach generating a prescription renewal request; (5) there is no type of prescriber in the system of Kaker; (6) there is no motivation to combine the teachings of Mayaud and Kaker.

33. In response to Applicants' argument (1), it is respectfully submitted that the electronic prescription renewal that is computer generated on a physician's handheld device in Mayaud is a form of computer generating a prescription renewal request as recited in claim 1. It is respectfully submitted that this interpretation follows from the other limitations recited in the claims. As described above in paragraph 4, a renewal prescription is received at some sort of prescription drug dispenser in response to the prescription renewal request generated on the physicians handheld. Furthermore, by receiving the prescription renewal, the dispenser is accordingly notified to fill the prescription.

34. In response to Applicants' argument (2), It is respectfully submitted that the claims do not recite a step of "receiving" a prescription renewal request. Rather the claims only recite steps of "generating" and "transmitting" a prescription renewal request. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is also noted that the Examiner has relied upon the teachings of Kaker for the step of "transmitting" and that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

35. In response to Applicants' argument (3), the Examiner respectfully submits that the claims merely recite computer monitoring an expiration date of a prescription. Therefore, it is further submitted that Applicants' arguments as to what the "monitoring" entails do not follow from a step that involves monitoring only a date. In particular, Applicants argue that monitoring "requires a computer programmed to oversee at least one prescription and keep track of it throughout its lifecycle on an ongoing basis" (see page 10 of the Remarks). Clearly, this is a much more involved process than merely monitoring a date. Therefore, it is respectfully

submitted that the calculations and reporting described by Kaker (see paragraphs 0030 and 0146), for the express purpose of providing "the benefit of knowing when it is time to renew" and to "remind the client that it is time to mail in the renewal application so that they will not run out of medications" (see paragraph 0147), is a form of monitoring an expiration date as recited in the claims.

36. In response to Applicants' arguments (4) and (5), it is respectfully submitted that Kaker teaches a prescription web form that can be automatically filled (see paragraph 0117). Furthermore, it is respectfully submitted that in the case of a prescription renewal, as described by Kaker, that the creation of this web form is a form of prescription renewal request generation. Furthermore, it is clear that in the system of Kaker the doctor who corresponds to each patient is the prescriber. Therefore, it is respectfully submitted that the teachings of Kaker, when combined with the teachings of Mayaud, describe these limitations as recited in the claims.

37. In response to Applicants' argument (6), it is submitted that while Mayaud describes a system that is broadly applicable to prescription management, Kaker is concerned with a particular subset of prescription management. In particular, Kaker is directed to providing a type of prescription assistance to Indigent patients. Kaker identifies this aspect of prescription management as desirable (see paragraphs 0006 and 0007). Therefore, the Examiner maintains that one of ordinary skill in the art would have been motivated to combine the teachings of Kaker with the teachings of Mayaud as described above in paragraph 4.

### ***Conclusion***

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

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39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CLG

6/27/05



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